Paper No. 10
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THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Warnaco Inc.

Serial No. 75/286,831

Trebor Lloyd of Amster, Rothstein & Ebenstein for Warnaco Inc.

Michael W. Baird, Trademark Examining Attorney, Law Office 109 (Ron Sussman, Managing Attorney)

Before Quinn, Chapman and Wendel, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Warnaco Inc. has filed an application to register the mark BRIGHT IDEA! for "women's intimate apparel, namely, bras and panties, camisoles, slips, tap pants, bustiers, and figure enhancing and body shaping garments, namely, girdles, control panties, bodysuits and bodyslips."[1]

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[1] Application Serial No. 75/286,831, filed May 5, 1997. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, if applied to its identified goods, would so resemble the registered mark, BRIGHT IDEAS "FOR YOU", INC., for "clothing, namely, boxer shorts, t-shirts, sweat shirts, and tank tops," as to be likely to cause confusion, mistake or deception.[2]

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register. In reaching this conclusion, we have considered all of the relevant du Pont[3] factors.

Turning first to a consideration of the respective goods, it is well settled that they need not be identical or even competitive to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See In re

[2] Registration No. 2,106,328, issued October 21, 1997. The claimed date of first use is April 26, 1995. The term "Inc." is disclaimed.

[3] See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

Peebles Inc., 23 USPQ2d 1795 (TTAB 1992); and Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590 (TTAB 1978).

Applicant contends that "The goods here, though related, are not identical"; and that in light of the differences between the marks, similarities between the goods will not lead to confusion. (Brief, pp. 4-5).

It is the Examining Attorney's position that both parties' goods are underwear-type clothing, and are sold in the same channels of trade (such as clothing stores and department stores) to the same classes of purchasers. In support of his position as to the relatedness of the respective goods, the Examining Attorney has made of record copies of pages from two catalogs (JCPenney and Victoria's Secret) showing that these companies offer both women's panties and women's boxer shorts; and that purchasers are accustomed to seeing both parties' goods sold under the same marks. The Examining Attorney also submitted copies of several third-party registrations, most of which issued on the basis of use in commerce,[4] to demonstrate the close relationship between applicant's goods (various items of women's intimate apparel and body shaping garments) and

[4] Two of the copies submitted by the Examining Attorney were of pending applications, and one third-party registration was based on a foreign registration. We did not consider these in reaching our decision.

registrant's goods (boxer shorts, t-shirts, sweat shirts and tank tops), by showing that a single entity has adopted a single mark for various combinations of these separate items (e.g., slips, camisoles, panties, bras, tank tops, boxer shorts, t-shirts).

Third-party registrations, however, are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nevertheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785 (TTAB 1993); and In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467, footnote 6 (TTAB 1988).

Regarding the respective trade channels and purchasers, the Board must determine the issue of likelihood of confusion on the basis of the goods as identified in the application and the registration. See Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). While applicant's identification of goods is limited to "women's" apparel items, there is no such limitation in the registrant's identification of goods.

Thus, the cited registration encompasses the enumerated clothing items for men, women and/or children. In addition, because there are no restrictions with respect to channels of trade, the Board must consider that the parties' respective goods could be offered and sold to the same class of purchasers through all normal channels of trade for such goods. See In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994); and In re Elbaum, 211 USPQ 639 (TTAB 1981). Further, this record establishes that at least some of the parties' respective goods (e.g., boxer shorts and women's panties), are sold to or for women through the same channels of trade (e.g., mail order catalogs).

Based on the record before us, we readily conclude that applicant's goods are closely related to the cited registrant's goods.

Turning to the marks, it is well settled that marks must be considered in their entireties because the commercial impression of a mark on an ordinary consumer is created by the mark as a whole, not by its component parts. This principle is based on the common sense observation that the overall impression is created by the ordinary purchaser's cursory reaction in the marketplace, not from a meticulous comparison of possible legal differences or

similarities. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 1999). See also, Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). That is, under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks.

There are obvious differences in the two marks involved herein, specifically that the term IDEA is singular in applicant's mark but plural in registrant's mark, applicant's mark includes an exclamation point, and registrant's mark includes the additional words and punctuation "FOR YOU", INC. However, these differences do not serve to distinguish the marks. Purchasers are unlikely to remember the specific differences between the marks due to the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. That is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of

Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992); and Edison Brothers Stores v. Brutting E.B. Sport-International, 230 USPQ 530 (TTAB 1986).

Moreover, it is the first part of a mark which is most likely to be impressed upon the mind of a purchaser and be remembered by the purchaser. See Presto Products Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895, 1897 (TTAB 1988). In this case, applicant's mark is BRIGHT IDEA! and the first two words in the registered mark are BRIGHT IDEAS (these words being arbitrary as applied to clothing). This plays a major part in creating the similarity of the overall commercial impression of these marks.

The connotation created by both marks, BRIGHT IDEA! and BRIGHT IDEAS "FOR YOU", INC., is the same for both parties in relation to their goods. That is, both refer to an intelligent choice, perhaps in clothing style or the very fact of purchasing the goods from that company. We are not convinced that applicant's mark connotes "a product in a playful fashion and suggests the usual array of colors [found on clothing items]", while registrant's mark "describes a company and attempts to evoke a personal relationship between the company [the goods and the

consumer].” (Reply brief, p. 2). See The Wella Corporation v. California Concept Corporation, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977).

Giving appropriate weight to all components of the involved marks, and considering the marks in their entireties, we find that these marks are similar in connotation and commercial impression. See In re Hearst Corp., 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992); and In re National Data Corp., 753 F.2d 1056 224 USPQ 749 (Fed. Cir. 1985).

Even if purchasers specifically realize that there are some differences between the involved marks, they may believe that applicant’s mark is simply a revised or shortened version of registrant’s mark, with both serving to indicate origin in the same source.

See generally, Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992) (Court affirmed Board holding of likelihood of confusion between KangaROOS and a kangaroo design for clothing, namely, athletic shoes, sweatsuits and athletic shirts and KANGOL and a kangaroo design for golf shirts having collars); In re Smith and Mehaffey, supra, (ROAD KILL CLUB OF AMERICA and design for t-shirts, sweatshirts and pullovers cited against ROAD KILL CATERING for t-shirts, sweatshirts and

aprons--refusal affirmed); Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986) (PRONTO and PRONTO in stylized lettering for a variety of personal and small business banking and financial services, computer programs, and instruction manuals describing the banking and financial services against PRONTOSYSTEM SIMPLIFIED LOAN FORMS FOR CREDIT UNIONS and design for paper forms for credit unions--opposition sustained); In re Apparel Ventures, Inc., 229 USPQ 225 (TTAB 1986) (SPARKS in stylized form for shoes, boots and slippers cited against SPARKS BY SASSAFRAS in stylized form for women's separates, namely blouses, skirts and sweaters--refusal affirmed); In re Logue, 188 USPQ 695 (TTAB 1975) (SPRING GLEN FARM KITCHEN in stylized lettering for a variety of prepared foods and condiments cited against SPRING GLEN for orange juice--refusal affirmed); Botany Industries, Inc. v. Patents Management Corporation, 171 USPQ 821 (TTAB 1971) (THE WALLSTREETER by Earhart for luggage against WALL STREET for luggage--petition to cancel granted); and In re Honeycomb, Inc., 162 USPQ 110 (TTAB 1969) (HONEYCOMB for brassieres cited against HONEYCOMB "BEE COMES YOU" and design for women's dresses--refusal affirmed).

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must

be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Based on the similarity of the connotations and commercial impressions of the marks, the close relationship of the parties' respective goods, the identity of the trade channels, and the overlap of consumers, we conclude that consumers would be likely to mistakenly believe that registrant's clothing items sold under the mark BRIGHT IDEAS "FOR YOU", INC. and applicant's clothing items sold under the mark BRIGHT IDEAS! originated with or are somehow associated with or sponsored by the same entity.

Decision: The refusal to register under Section 2(d) is affirmed.

T. J. Quinn

B. A. Chapman

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board